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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,702	10/23/2001	Frank M. Zizzamia	098056/00135	5389
31013 7590 12/23/2010 KRAMER LEVIN NAFTALIS & FRANKEL LLP INTELLECTUAL PROPERTY DEPARTMENT 1177 AVENUE OF THE AMERICAS NEW YORK, NY 10036				
EXAMINER VYAS, ABHISHEK				
ART UNIT 3691		PAPER NUMBER		
NOTIFICATION DATE 12/23/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

klpatent@kramerlevin.com

Office Action Summary

Application No.

10/054,702

Applicant(s)

ZIZZAMIA ET AL.

Examiner

ABHISHEK VYAS

Art Unit

3691

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the **request for continued examination** filed on 04/22/2010
2. Claims 1-34 are currently pending and have been examined.
3. Claims 1-34 are rejected.
4. This is a non-final rejection.
5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/22/2010 has been entered.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 20-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
8. Claims 20 and 23 recite in the preamble "A system". The body of claims recites "code means" for each limitation (database). Therefore the claims are non-statutory because it is directed towards software, per se, lacking storage on a medium, which enables any underlying functionality to occur. It is not clear whether instructions are in executable form and therefore there is no practical application.
9. The dependent claims are rejected on the basis of the rejected independent claims.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1 and 3-34 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Apte et al. (5,970,464; hereinafter Apte), DeTore et al. (4,975,840;

hereinafter DeTore) and further in view of Zizzamia (5,893,072; hereinafter Zizzamia).

12. Claim 1 recites A data processing machine comprising a program storage device

readable by said machine said program storage device tangibly embodying a program of instructions executable by the machine to perform a method for predicting the profitability of a commercial insurance policy, said method comprising:

13. obtaining policyholder data including premium and loss data from a database

(Apte: abstract; col. 1, lines 53-60; col. 3, lines 9-19; lines 35-46; Fig. 1-14);

14. obtaining external data directed to at least one of business level data and

household demographics data, the external data having a plurality of external variables to be used in predicting the profitability of the insurance policy (Apte: col. 3, lines 5-19; col. 3, lines 35-46; Fig. 1-14);

15. associating the external variables with the policyholder data (Apte: col. 3, lines 9-19 and lines 44-53);
16. evaluating the associated external variables against the policyholder data to identify the individual external variables predictive of the insurance policy's profitability (Apte column 3, lines 34-42 and Figure 10) and

Apte, however, fails to expressly disclose a method for predicting the profitability of an insurance policy comprising the following steps.

Nevertheless, this feature is old and well known in the art, as evidenced by DeTore and Zizzamia. In particular, DeTore and Zizzamia disclose a method for predicting the profitability of an insurance policy comprising the steps of:

- i. creating a score based on an individually weighted multivariate statistical model based on said individual external predictive variables, wherein said evaluating external variables includes evaluating the utility of creating new variables from the external variables (DeTore column 14, lines 23-44: "*...a description of key data and strategies used for underwriting the subject problem, suggestions as to any additional information that should be obtained to adequately underwrite the case and the specific underwriting action recommended including any other additional factors which should be considered"; "weights"; column 15, lines 42-65) and creating any appropriate new variables wherein said*

score is expressed as a sum of products each of said products being a coefficient multiplied by a variable taken to a power (DeTore column 16, lines 5-19, 35-59; column 18, lines 50-60) and

ii. wherein said score is a function of at least all of the predictive external variables and any predictive new variables

- (1) evaluating the associated external variables against the policyholder data to identify the individual external variables predictive of the insurance policy's profitability and creating a score based on statistical model; score is expressed as a sum of products each of said products being a coefficient multiplied by a variable taken to a power (DeTore: abstract; col. 7, lines 9-23; col. 15, lines 42-59, col. 15, line 60 to col. 16, line 19, Fig. 10-13);
- (2) a multivariate statistical model (Zizzamia: col. 9, lines 18-21).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of DeTore with the combined teachings of Apte and Zizzamia with the motivation of providing a method and apparatus for evaluating the insurability of a potentially insurable risk (DeTore: col. 1, lines 55-58).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Zizzamia with the combined teachings of Apte and Zizzamia with the motivation of providing a

method and apparatus for evaluating the insurability of a potentially insurable risk (DeTore: col. 1, lines 55-58).

17. Claims 3-12 have been amended to recite "a data processing machine" instead of the method. These claims are rejected for the same reasons given in the previous office action (pages 7-14) and incorporated herein.

18. Claim 13 has been amended now to recite A data processing machine comprising a program storage device readable by said machine said program storage device tangibly embodying a program of instructions executable by the machine to perform_a method for creating a statistical model that generates a score representative of the profitability of an insurance policy for at least one of a new policyholder and an existing policyholder, said method comprising:

- i. gathering historical policyholder data including loss and premium data (Apte: abstract; col. 1, lines 53-60; col. 9, lines 29-36; Fig. 1-14);
- ii. identifying external data sources having a plurality of external variables, each external variable having a value (Apte: col. 3, lines 5-19; Fig. 1-14);
- iii. calculating a loss ratio for each policyholder in the database based on the working data (Apte: abstract; col. 1, lines 53-60; col. 9, lines 29-36; Fig. 1-14);
- iv. calculating a cumulative loss ratio for a defined group of policyholders in the database (Apte: abstract; col. 1, lines 53-60; col. 9, lines 29-36; Fig. 1-14); and

v. an individually weighted statistical model (Apte: col. 6, lines 46-60). Apte does not teach the following limitations. Nevertheless, these features are old and well known in the art, as evidenced by DeTore and Zizzamia. In particular, DeTore and Zizzamia disclose a method for creating a statistical model that generates a score representative of the profitability of an insurance policy for at least one of a new policyholder and an existing policyholder, comprising the steps of:

- (a) applying actuarial transformation to the policyholder data to generate working data (DeTore: abstract; col. 16, lines 20-34; Fig. 1-12);
- (b) performing a statistical analysis that investigates the relationship of each external variable and the cumulative loss ratio for the defined group to identify external variables that are predictive of the profitability of the insurance policy (DeTore: abstract; col. 4, lines 36-53; Fig. 1-12);
- (c) utilizing the predictive external variables identified in the previous step to develop a statistical model that generates a score predictive of the profitability of the insurance policy, wherein said performing a statistical analysis includes evaluating the utility of creating new variables from the external variables and creating any appropriate new variables, and wherein said score is a

function of at least all of the predictive external variables and any predictive new variables, wherein said score is expressed as a sum of products, each of said products being a coefficient multiplied by a variable taken to a power, (DeTore: abstract; col. 4, lines 36-53, col. 15, lines 42-59, col. 15, line 60 to col. 16, line 19, line Fig. 1-12); (d) a multivariate statistical model (Zizzamia: col. 9, lines 18-21).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of DeTore with the combined teachings of Apte and Zizzamia with the motivation of providing a method and apparatus for evaluating the insurability of a potentially insurable risk (DeTore: col. 1, lines 55-58).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Zizzamia with the combined teachings of Apte and Zizzamia with the motivation of providing a method and apparatus for evaluating the insurability of a potentially insurable risk (DeTore: col. 1, lines 55-58).

D. Claims 14-19 have been amended to recite "a data processing machine" instead of the method. These claims are rejected for the same reasons given in the previous office action (pages 18-20) and incorporated herein.

E. Claim 20 has been amended to include: wherein said score is expressed as a sum of products, each of said products being a coefficient multiplied by a variable taken to a power. The obviousness of modifying the teaching of Apte to include this limitation (as taught by De Tore) is as addressed above in the rejection of claims 1 and 13 and incorporated herein.

F. Claims 21-22 have not been amended, and Applicant does not appear to argue the separate patentability of these claims. As such, claims 21-22 are rejected for the same reasons given in the previous Office Action (pages 20-21), and incorporated herein.

G. Claims 23 and 25 have been amended to include: wherein said score is expressed as a sum of products, each of said products being a coefficient multiplied by a variable taken to a power. The obviousness of modifying the teaching of Apte to include this limitation (as taught by De Tore) is as addressed above in the rejection of claims 1 and 13 and incorporated herein.

H. Claims 24 has not been amended, and Applicant does not appear to argue the separate patentability of this claim. As such, claim 24 is rejected for the same reasons given in the previous Office Action (pages 21-22), and incorporated herein.

I. Claims 26-32 have been amended to recite "a data processing machine" instead of the method. These claims are rejected for the same reasons given in the previous office action (pages 23-24) and incorporated herein.

J. Claim 33 has been amended to include: wherein said score is expressed as a sum of products, each of said products being a coefficient multiplied by a variable taken to a power. The obviousness of modifying the teaching of Apte to include this limitation (as taught by De Tore) is as addressed above in the rejection of claims 1 and 13 and incorporated herein.

K. Claims 34 has not been amended, and Applicant does not appear to argue the separate patentability of this claim. As such, claim 34 is rejected for the same reasons given in the previous Office Action (pages 24), and incorporated herein.

Response to Arguments

A. Applicant's arguments filed 4/10/2008 have been fully considered but they are not persuasive.

B. The examiner notes that Apte is directed towards "**A computer implemented method of underwriting profitability analysis** delivers the analytic process to a wide cross section of insurance decision makers... Data mining techniques are applied to historical policy and claims to extract rules that describe policy holders with homogeneous claim frequency and severity characteristics. Therefore there is a teaching of using external data from data

warehouses. These rule sets are used to classify policy holders into distinct risk groups, each with its own set of characteristics, including pure premium." The screen in Figure 8 allows a user to see in further detail particulars about a model or an edited rule set that has been selected from the existing models screen. In addition to identifying the database name on which the model was trained or evaluated, this screen also displays the accuracy estimate of the model in terms of several statistics." In col. 6, lines 46-52.

C. To reiterate: De Tore teaches **"A method and apparatus for evaluating the insurability of a potentially insurable risk** has data bases for storing information, and the ability to correlate selected elements of information in respective data bases. Certain elements are assigned weights on the basis of predetermined relationships existing between elements of information in one data base and corresponding elements of information in another... In one embodiment, the system can identify an element of information for which no corresponding information exists, and for which no expert module exists. Other features include the ability to override an expert module and assign a different weight to an element of information; **the use of statistical profiles to adjust assigned weights**, the ability to determine expected profitability resulting from decisions concerning a particular risk, and the provision of additional data bases useful in managing workload and customizing operation of the system." In abstract. Under the broadest reasonable interpretation "multivariate statistics or

multivariate analysis" is interpreted as a collection of procedures which involve observation and analysis of more than one statistical variable at a time.

D. In response to Applicant's argument about "Zizzamia fails to describe a score expressed as a sum of products, each of said products being a coefficient multiplied by a variable taken to a power. "; Examiner respectfully submits that De Tore teaches "After the individual weights are assigned to each problem, and after the weights are adjusted according to any applicable statistical profiles, the weights must be combined to determine an overall risk assessment for the case. There are several ways in which this can be done. For example, one method is to compare the individual weights to a standard mortality rating to determine a mortality ratio for each problem. The individual ratios can then be combined to determine an overall mortality ratio for the individual. In determining the final ratio, it has been found that certain problems or impairments interact to produce positive or negative effects that are not truly represented by a simple additive combination. Block 108 of FIG. 6 represents the process of combining the weights or ratios assigned to individual problems to determine a final ratio or rating. The process of block 108 includes the process of identifying combinations of problems which represent more or less severe impairments than would result if the subject problems occurred individually, and adding (or subtracting) an extra "combination" weight to the total. For example, if an applicant has hypertension (problem A) and is a diabetic (Problem B), individual weights or ratios would be assigned for problem A and problem B, in accordance with the methodology

described above, and then the system at block 108 would assign an additional weight or ratio upon recognizing the existence of problems A and B in combination." In col. 15, line 60 to col. 16, line 19.

E. In order to provide support for examiner's assertion, the examiner would like to cite US Patent No.: 7,072,841 B1 to Pednault. This reference is not relied upon in the rejection but is considered pertinent and relied upon as secondary evidence towards obviousness. Pednault in column 9, lines 26-47 teaches the use of different statistical models for predictive modeling to ensure profitability (column 11, lines 14-22; 43-61; column 16, lines 49-64; column 17, lines 18-25).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abhishek Vyas whose telephone number is 571-270-1836. The examiner can normally be reached on 7:30am-5:00pm EST Mon-Thur, ALT Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. V./
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691